

**REMARKS/ARGUMENTS**

Claims 1, 2 and 4-22 are present in this application. By this Amendment, claims 1, 14, 21 and 22 have been amended, and claim 3 has been canceled. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Claims 1-5, 7-9, 12, 14-16, 19 and 20 were rejected under 35 U.S.C. §101. Without conceding this rejection, independent claims 1 and 14 have been amended according to the Examiner's suggestion to reference "machine/processor/computer network system or necessary hardware and software" for performing the claimed method. Withdrawal of the rejection is requested.

Claims 1-5, 7-9, 12, 14-16 and 18-22 were rejected under 35 U.S.C. §112, first paragraph. Without conceding this rejection, the phrase with regard to a user and not a vendor compiling the user profile has been deleted. Withdrawal of the rejection is requested.

Claims 1-5, 7-9, 12, 14-16 and 18-22 were rejected under 35 U.S.C. §103(a) over U.S. Published Patent Application No. 2001/0014868 to Herz et al. in view of U.S. Published Patent Application No. 2002/0033416 to Gerszberg et al. and U.S. Published Patent Application No. 2002/0026363 to Dunaway, Jr. This rejection is respectfully traversed.

The Office Action recognizes that the Herz publication lacks the claimed step of providing the user with an option to incorporate in the user profile an automatic best choice service, wherein if the user profile incorporates the automatic best choice service, automatically accepting the relevant items without user intervention . . . . In this context, however, the Office Action contends that Dunaway discloses this subject matter. In contrast with the claimed invention, however, Dunaway describes that for the few clients that prefer not to interact with the website, a manager can set their profile for automatic menu selection. As such, although the user

is provided with an option of automatic menu selection, the option is set by a manager rather than the user. In an effort to clarify this distinction, the independent claims have been amended to define a step of providing the user with an option selectable via the user computer to incorporate in the user profile an automatic best choice service. As such, the user selects the option at their control via the user computer. In view of at least this distinction, Applicant respectfully submits that the rejection is misplaced.

In addition, with reference to previously-submitted arguments with regard to the Herz publication, which are hereby incorporated by reference, Applicant respectfully submits that Herz teaches away from any modification to include an automatic best choice service wherein relevant items are automatically accepted without user intervention. As discussed previously, Herz is a profiling system that monitors consumer behavior and provides offers for products to consumers that may be desirable to the user based on prior shopping history and the like. These offers, promotions and products are not solicited by the users. Incorporating an automatic best choice service where products may be automatically purchased without user intervention is entirely inappropriate, and in fact is illegal under the Consumer Protection Act. It is clear then that Herz lacks any suggestion to modify its system to incorporate any vehicle that enables selected items to be automatically accepted without user intervention. Moreover, even under the Supreme Court's recent decision in *KSR International*, a resulting methodology that is legally suspect is far from predictable. Similarly, use of a "known technique" in *KSR* relates to an "improvement" in a similar device. Applicant submits that modifying the Herz system as proposed in the Office Action to encompass illegal methods is hardly an "improvement," and those of ordinary skill in the art would not have been led to a similar conclusion. For these reasons also, Applicant respectfully submits that the rejection is misplaced.

With regard to the dependent claims, Applicant submits that these claims are allowable at least by virtue of their dependency on an allowable independent claim.

Reconsideration and withdrawal of the rejection are respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims are patentable over the art of record and that the application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Prompt passage to issuance is earnestly solicited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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